



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/218,916	12/22/1998	LARRY A. NICKUM	450.251US1	2458

32710 7590 11/02/2004

Stites & Harbison PLLC
TransPotomac Plaza
1199 North Fairfax Street, Suite 900
Alexandria, VA 22314-1437

EXAMINER

RAO, SHEELA S

ART UNIT PAPER NUMBER

2125

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

09/218,916

Applicant(s)

NICKUM, LARRY A.

Examiner

Sheela Rao

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2125

1. Applicant's response filed on June 21, 2004 has been entered and considered.
2. No amendments have been made to the claims. Claims 1-23 remain pending and are presented for examination.

Response to Amendment & Declaration

3. The addition of "wireless notification transceiver" to claims 1, 7, 8, and 13 is noted. Applicant states that the term "wireless" was "erroneously omitted from the claims provided in the response filed July 7, 2003." For purposes of clarification, the claims that were presented in the RCE filed on October 10, 2003 also did not include the "wireless" limitation. Thus, the amendment filed on July 21, 2004 contains the first iteration of "wireless" since the filing of the RCE. Examiner will not consider the addition of "wireless" as new matter as it was previously introduced in the prosecution of this application.
4. In response to the declaration filed on October 10, 2003, Examiner maintains that the declaration filed on October 10, 2003 is ineffective to overcome the Ruckdashel reference (USPN 6,038,542) under 37 CFR 1.131. The Examiner has reviewed the affidavit and exhibits previously presented, along with Applicant remarks presented in the current amendment. The exhibits are insufficient because (a) they do not provide sufficient factual evidence of conception, nor of effective reduction to practice, of the instant invention commensurate in scope with the instant claims, and (b) they do not provide sufficient factual evidence of reasonable diligence between the alleged date of conception and the alleged date of effective reduction to practice.

- ***Conception --***

The declaration is inadequate because of a lack of sufficient proof of conception. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Ruckdashel reference.

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be

comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). See MPEP 715.07.

As per MPEP 715.07, a general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131 (b). *In re Borkowski*, 505 F. 2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant, 505 F. 2d at 718-19, 184 USPQ at 33. See *In re Harry* 333 F. 2d 920, 142 USPQ 164 (CCPA 1964). The burden of proof is upon the Applicant.

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country, at least the conception being at a date prior to the effective date of the reference, i.e. April 28, 1998.

In this case, there is no clear explanation of the invention where the exhibits support the limitations of the instant invention. Applicant states in paragraph 4 of the declaration that "Exhibit A is factual evidence that the invention was conceived in the US prior to April 28, 1998. Exhibit A is a ... disclosure form ... [that] describes aspects of the invention as claimed." This general conclusory statement accounts to "mere pleading". Furthermore, the declaration does not provide a clear explanation of how the exhibits support conception of the claimed invention.

In particular, Exhibit A broadly describes the invention, but does not detail the features of the claimed limitations. Examiner has considered and evaluated the exhibits for what they show. Support for a notification controller or a wireless notification transceiver in the supplied exhibits is not found. Furthermore, details as to how to make and/or use these limitations have not been provided. Applicant has outlined what is already known in the art regarding the technology of paging transmitters, the use of a

"wireless notification transceiver" is nowhere mentioned and/or addressed, but is a claimed limitation. Exhibit B is a mere reiteration of what was presented to a search agency in the disclosure provided by the Applicant. The statement on page 2 simply indicates the initiation of a search, but does not provide evidence of the conception of the invention, proof of reduction to practice or diligence regarding the limitations of the instant invention. Exhibit C has no information regarding the scope of the invention and does not support the intent of the instant claims; it is only a letter initiating the preparation of formal papers. Therefore, the affidavit is inadequate. The aforementioned issues are exemplary in nature, the burden is on the Applicant to overcome the reference by establishing sufficient explanation.

- Diligence –

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective, i.e. April 28, 1998, is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

Since conception has not been sufficiently shown, diligence need not be considered. Nonetheless, in the name of compact prosecution, Examiner has reviewed the documents submitted and evaluated their contents and found that the burden of proof has not been met.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Ruckdashel reference to either a constructive reduction to practice or an actual reduction to practice.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity, which is April 28, 1998 for the Ruckdashel patent, and ends with the date of a reduction to practice, either actual or constructive, which is the filing of the instant application on December 22, 1998. An applicant must account for the entire period during which diligence is required either by affirmative acts or acceptable exhibits. See *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). See MPEP 2138.06.

At paragraph 5 of Applicant's declaration, it is stated, "that the invention was diligently pursued subsequent to its conception. ... A final draft was executed and filed on December 22, 1998 ..." this

statement is a merely a general allegation as to the diligent pursuit of the invention attempting to account for a period of 8 months. As per MPEP 2138, the activities involved in diligence must be clearly accounted for during the entire period disclosed. See *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (SSPA 1964) wherein a statement that the subject matter "was diligently reduced to practice" was determined to not be a showing but a mere pleading. In the presented exhibits for the instant invention, no acts or dates were submitted in support of diligence. Therefore, the evidence is not adequate to enable the Examiner to conclude that the Applicant was diligent in pursuing the invention as claimed.

Applicant is advised to refer to MPEP 2138.04-2138.06 for guidance regarding proof of conception, reduction to practice and diligence.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 7, 8, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 7, 8, and 13 include the limitation of a "wireless notification transceiver". The Detailed Description portion of the specification at page 9, line 19, seems to be the first and only mention of a "wireless" communication environment. Only the capability of the devices to communicate in a wireless environment is all that has been stated. Yet, there is no evidence of how a "wireless notification transceiver is communicatively connected to the notification controller and is capable of transmitting a signal", nor has the operative information of the "software to control a notification controller coupled to a bus and a wireless transceiver" for signaling upon detection of an event been made for one of ordinary skill to make and/or use the invention as claimed.

7. The rejection of claims 1-23 under 35 USC 103(a) as being unpatentable over Tabuchi (USPN 5,822,583) in view of Ruckdashel (USPN 6,038,542) is **maintained** and has been restated below.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabuchi (USPN 5,822,583) in view of Ruckdashel (USPN 6,038,542).

Tabuchi discloses an event generating and delivering system in a computer system that dynamically generates the event corresponding to the output, and automatically executes the process corresponding to the generated event. The event generating and delivering or notification system of the patented invention includes a data processing system that comprises a notification controller and transceiver, as per instant claims 1, 6, and 7, is shown in Figure 1 of the reference. The computer including a processor and memory is shown in Figure 1 to be element 102 – the data processing system. Within the data processing system, a signal converting portion and an event generating and delivering portion is present. The event generating and delivering portion, element 122, is similar to the notification controller of the instant invention. See column 4: line 66, et seq.

As for the limitation of “a wireless notification transceiver communicatively connected to the notification controller and capable of transmitting a message containing data”, Tabuchi teaches this in column 1 at lines 28-32, wherein it is stated that an “event generating and delivering portion generates an event corresponding to an input data ...”. The prior art of Tabuchi does not teach the use of wireless transmission, but the method of notification of Ruckdashel uses such for communication. Examiner directs Applicant to the Abstract, column 4:line 42, as well as claims 7 and 13 of the patented invention of Ruckdashel ('542); wherein the use of a wireless transmitter and/or receiver (transceiver) is stated. Ruckdashel teaches the use of a wireless pager or wireless telephone, both of which include a wireless transceiver. It is well known in the art that wireless transceivers operate with the use of RF frequency and is inherent to wireless pagers and telephones. Additionally, Tabuchi does not identify the “generated event” (i.e. notification) as being a “message containing data” about an operation. In this regard, Ruckdashel teaches notification as being in the form of a message (see column 3: lines 26-32 of Ruckdashel). It would have been obvious to one of ordinary skill in the art at the time the invention was

made to have used a wireless device for notification of events or messages so as to establish communication at any time and to provide the established desirable benefit of portability.

Tabuchi fails to teach of a portable transceiver for receiving messages as claimed by the instant invention. The patent to Ruckdashel teaches of a system for notification of a scheduled event through the use of portable devices such as pagers and wireless telephones. The inclusion of portable communication devices in the event notification system of Tabuchi would allow for better access to the user or respondent. It would have been obvious to one of ordinary skill in the art to have included the portable devices of Ruckdashel to the notification system of Tabuchi at the time the invention was so as to have achieved more flexibility, quicker access, and a more efficient system.

As per the limitations of claims 2-5, Tabuchi teaches the use of graphic and audio output devices as a means of delivery of the event. Additionally, the invention of Ruckdashel also teaches the use of LED, LCD, and audible messages with the use of the portable communication devices.

With regard to claims 8 and 13, the generation of an event from a software application, detecting the event, signaling the notification controller and transmitting a message is taught by Tabuchi in column 1, lines 24-45 and column 4, lines 44-61. In addition, Ruckdashel teaches the use of "signaling software controlling a notification controller coupled to a bus and a transceiver" as can be seen in Figure 1 of the reference of prior art. In Figure 1, Ruckdashel illustrates item 112 as a bus and item 104 as the transceiver. The input/output module for both transmitting and receiving data, item 104, includes "circuitry for interfacing the processor with other devices within the computer system including the display or output device"

Tabuchi as modified by the invention of Ruckdashel would include the limitations of claims 9-10, and 14-15 as it is disclosed by Tabuchi that a number of application programs are run and based on the type of event appropriate processing with respect to the event is output. Ruckdashel teaches the limitation as claimed, see abstract and column 3, line 1, et seq. The limitations of claims 12, 17-20 and 22-23 are obvious to the use of portable transceivers or devices as they are used to notify and/or relay messages in this art area. As to the limitation of claims 11 and 16 wherein the generating of an event comprises an interrupt request, this too is obvious to the function of an application program.

As per the limitation of claim 21 that claims the notification transceiver to operate at a frequency licensed for local use, this limitation is not a technical limitation it is a legal standard. As applicant has already admitted on page 6, lines 18-20, of the instant disclosure, the transmission of signals at licensed frequencies is typical as per licensing by the FCC.

For the reasons stated above, the limitations of the claimed invention are taught by the prior arts of record; thereby, rendering the instant claims unpatentable.

Response to Arguments

10. Applicant's arguments filed June 21, 2004 have been fully considered but they are not persuasive.

- a) With regard to Applicant's comments about the statement indicating insufficiency of the declaration submitted on October 10, 2003, Examiner has responded as stated above in paragraph 4.
- b) With regard to Applicant's comments about the rejection of claims 1-23 under 35 USC § 103(a) as being unpatentable over Tabuchi in view of Ruckdashel, Examiner maintains the previously made rejections as re-cited above in paragraph 9.

Applicant argues that the references relied upon do not teach the "wireless transceiver" limitation. In order to clarify the occurrence of the "wireless" limitation in the history of this application, Examiner establishes the following "time-line" ...

Amended claims submitted/received February 25, 2003 → includes "wireless" in claims;

Final Rejection mailed May 7, 2003 → addresses "wireless" limitation in response to arguments;

Amendment filed/received July 11, 2003 → no mention of "wireless" in claims in amendment after final;

Request for RCE filed/received October 10, 2003 → no mention of "wireless" in claims;

Non-Final Rejection mailed December 12, 2003 → previous rejection maintained;

Amendment filed/received June 21, 2004 → includes "wireless" in claims and states it's erroneous omission.

In response to Applicant's argument that the references of prior art do not teach/fairly suggest the use of "a wireless notification transceiver communicatively connected to the

notification controller and capable of transmitting a signal including a message containing data on the event", as per the instant claims, Examiner responds by directing Applicant to the Abstract, column 4:line 42, as well as claims 7 and 13 of the patented invention of Ruckdashel ('542); wherein the use of a wireless transmitter and/or receiver (transceiver) is stated. Ruckdashel teaches the use of a wireless pager or wireless telephone, both of which include a wireless transceiver. It is well known in the art that wireless transceivers operate with the use of RF frequency and is inherent to wireless pagers and telephones. The use of this type of technology in the patented invention as cited for rejecting the instant claims renders Applicant's argument on this matter moot. Furthermore, Applicant does not clearly disclose the operative details of the "wireless transceiver" so as to enable skilled artisans to make/use the invention, thereby constituting the need for the enablement rejection as stated above in paragraphs 5 and 6.

■ In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The rejection of claims 1-23 was rendered unpatentable based on the combination of the Tabuchi and Ruckdashel references. For a 35 USC § 103 rejection using two references to be made, reference A is taken in view of reference B. Applicant has viewed the reference individually and argues them as such; thereby, making piecemeal arguments. The primary reference of prior art to Tabuchi, teaches transceivers while the secondary reference to Ruckdashel, teaches the use of wireless technology. Examiner acknowledges that the invention by Tabuchi does not teach the use of wireless transceivers. It is for this reason that the invention by Ruckdashel is relied upon. The combination of the two references, Tabuchi in view of Ruckdashel, renders an event notification and delivering system/method as per the limitations of the instant invention. Based on the use of the combination of the two references, there is no need for the disclosure by Ruckdashel to repeat the features of the Tabuchi invention. The combination of the two references of prior art

Art Unit: 2125

teach and/or fairly suggest the features of the claimed invention; thereby, rendering the instant invention obvious and unpatentable.

Conclusion

11. Although, it would appear a Final office action would be proper, this office action is not being made final in order to allow the Applicant additional time for response, since the "wireless notification transceiver" was not fully addressed in the last Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela Rao whose telephone number is (571) 272-3751. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

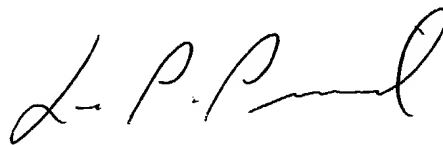
or faxed to:

(703) 305-3718 for Official Communications

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Sheela S. Rao
October 25, 2004



**LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**